

Appl No.: 10/694,298

Atty. Dkt.  
PC1604**REMARKS/ARGUMENTS**

Favorable consideration of this application is respectfully requested. Applicant has rewritten claim 1, added new claims 21-31 and canceled claims 2, 4-6, 12-20. Favorable reconsideration of this application is, consequently, earnestly solicited in view of the following remarks.

As to the restriction requirement, applicant has canceled nonselected claims 12-20 and reserves the right to file a divisional application.

Claim 1 was rejected under sec. 112 as being indefinite. Applicant has made a good faith effort to clarify the "carbohydrate" language in claim 1. No new matter has been entered. Support for this amendment can be found on pages 4-5 of the application. Thus, removal of this rejection is respectfully requested.

Claims 1-2 and 8 were rejected under sec. 102b as being anticipated by Laaman '136. This reference describes a "low fat, shelf-stable, ready-to-drink milk shake beverage..." title, and fails to describe, teach or suggest the novel first and second "pre-blended mixture(s)" of novel ingredients as specified in amended claim 1. Furthermore, Laaman does not describe, teach or suggest the novel combination of an "approximately single teaspoon" of the "first pre-blended mixture" with an "approximately single half cup of the second pre-blended mixture."

The features of the dependent claims and the new claims are also not described, taught or suggested by this reference. For example, the novel claimed proportion amounts of the first pre-blended mixture and proportion amounts of the second pre-blended mixture of claims 24, 25, 26, the whipped and blended features of claims 21-23,

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30-31 as described on pages 4-5 and in the figure are also not described, taught or suggested by this reference. Thus, removal of this rejection is respectfully requested.

Claims 3-11 were rejected under sec. 103 as being unpatentable over Laaman in view of Merrick. The Merrick reference does not overcome the deficiencies to Laaman described above. Merrick describes a "low fat edible emulsion", title, and does describe teach or suggest the novel "single teaspoon" amount of the "first pre-blended mixture" of specified components that is mixed together with the "single half cup" amount of the second pre-blended mixture" of specified components of claim 1.

Additionally, Merrick does not describe, teach or suggest the novel claimed proportion amounts of the first pre-blended mixture and proportion amounts of the second pre-blended mixture of claims 24, 25, 26, the whipped and blended features of claims 21-23, 30-31 as described on pages 4-5 and in the figure are also not described, taught or suggested by this reference.

It is clearly improper for the examiner to arbitrarily ignore any of the novel features of the claims. Under the rules, if the applicant requests the examiner cite the reference(s) showing each and every one of the references that supports a rejection, the examiner must cite the reference or remove the rejection. Applicant requests the examiner specifically point out which uncited reference(s) describes and teaches these unsubstantiated opinions and assertions raised in the rejection that at least these features are obvious under sec. 103. If actual references are not cited and supplied to the applicant to show these unsubstantiated opinions and assertions mentioned in their rejection, the applicant respectfully requests removal the 103 rejection for at least these reasons alone.

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For example, applicant disagrees with the examiner's assertion that "it would be expected that these compositions (of claims 7-11) are included because it is well known in the art..." Applicant cannot rely on personal feelings of the examiner to respond to a rejection, and must rely on actual references. Thus, removal of this rejection is respectfully requested for at least these reasons alone.

Arguably, it might be "obvious to try" to create the novel invention claimed by applicant's claims. However, Examiner is well aware that "obvious to try" is not the standard for determining inventiveness. See also *In re Kaplan*, 789 F. 2d at 1580, 229 U.S.P.Q. at 683, where the court held:

"In effect, what the Board did was to use a disclosure of appellants' own joint invention which had been incorporated in the Kaplan sole disclosure to show that their invention was but an obvious variation of Kaplan's claimed invention. That amounts to using an applicant's invention disclosure, which is not a 1-year time bar, as prior art against him. That is impermissible."

The mere fact that someone in the art can rearrange parts of a reference device to meet the terms of a claim is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for someone of ordinary skill in the art, without the benefit of the inventor's specification to make the necessary changes in the reference device. *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

There is no teaching, nor suggestion for modifying the references of record to include all the novel features of the amended claims. Under well recognized rules of the MPEP (for example, section 706.02(j)), the teaching or suggestion to make the claimed

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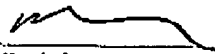
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combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vacck*, 947 F.2d 488, 20 USPQ2d 1438(Fed. Cir. 1991).

Applicant contends the references cannot be modified to incorporate the features of subject claims 1, 3, 7-11 and 21-32 without utilizing Applicant's disclosure. The courts have consistently held that obviousness cannot be established by combining the teachings of the prior art to Applicant to produce the claimed invention, absent some teaching, suggestion, incentive or motivation supporting the combination. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

In view of the foregoing considerations, it is respectfully urged that claims 1, 2, 8, 12-16 and 19-26 be allowed. Such action is respectfully requested. If the Examiner believes that an interview would be helpful, the Examiner is requested to contact the attorney at the below listed number.

Respectfully Submitted;

  
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